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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,618	12/04/2003	Piero Patrone Bonissone	52493.000310	5754

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EXAMINER	
KANG, IRENE S	

ART UNIT	PAPER NUMBER
3695	

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04/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/726,618	BONISSONE ET AL.	
	Examiner	Art Unit	
	IRENE KANG	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *04/07/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following is a Non-Final Office Action in response to communications received February 2, 2010. Claim 17 has been amended. Claims 1-18 remain pending and examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to **Claims 9-12**, independent Claim 9 recites a system with modules for identifying, assessing, and making a decision. This is considered to be software per se unless there is an apparatus as well that is capable of executing the software appropriately in order to provide functionality. In other words, for applicant to claim the steps performed by the program, the applicant must recite the claims such that when the program is executed, the program causes a computer/processor to perform the steps. Claims 10-12 are dependent claims and are rejected in a like manner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the patent by DeTore et al. (Patent No.: 4,975,840).

As to Claim 1, *DeTore* teaches a method for using medication and medical condition information in automated insurance underwriting, the method implemented on a tangibly embodied computer readable medium in the form of executable code for causing a processor to use medication and medical condition information in automated insurance underwriting, the method comprising the steps of:

identifying medication information provided by an applicant (see at least Col. 8, lines 8-39);

identifying medical condition information provided by the applicant (see at least Col. 8, lines 8-39);

assessing a consistency between the medication information and the medical condition information, the assessing a consistency between the medication information and the medical condition information performed by the processor (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information (see at least Figure 1; Col. 3, line 63 through Col. 6, line 8; Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36).

As to Claim 2, *DeTore* teaches: generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

comparing the list with the medical condition information provided by the applicant (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36).

As to Claim 3, *DeTore* teaches querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions (see at least Col. 5, line 40 through Col. 6, line 21; Col. 10, line 31 through Col. 11, line 36; and Col. 12, lines 1-36).

As to Claim 4, *DeTore* teaches assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information (see at least Figure 1; Col. 3, line 63 through Col. 6, line 8; Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36).

Claim 5 is the tangibly embodied computer readable medium executing code for causing a processor to perform the method of Claim 1 and is thereby rejected under the same reasoning as Claim 1.

Claim 6 is the tangibly embodied computer readable medium executing code for causing a processor to perform the method of Claim 2 and is thereby rejected under the same reasoning as Claim 2.

Claim 7 is the tangibly embodied computer readable medium executing code for causing a processor to perform the method of Claim 3 and is thereby rejected under the same reasoning as Claim 3.

Claim 8 is the tangibly embodied computer readable medium executing code for causing a processor to perform the method of Claim 4 and is thereby rejected under the same reasoning as Claim 4.

Claim 9 is the system to perform the method of Claim 1 and is thereby rejected under the same reasoning as Claim 1.

Claim 10 is the system to perform the method of Claim 2 and is thereby rejected under the same reasoning as Claim 2.

Claim 11 is the system to perform the method of Claim 3 and is thereby rejected under the same reasoning as Claim 3.

Claim 12 is the system to perform the method of Claim 4 and is thereby rejected under the same reasoning as Claim 4.

Claim 13 is the system to perform the method of Claim 1 and is thereby rejected under the same reasoning as Claim 1.

Claim 14 is the system to perform the method of Claim 2 and is thereby rejected under the same reasoning as Claim 2.

Claim 15 is the system to perform the method of Claim 3 and is thereby rejected under the same reasoning as Claim 3.

Claim 16 is the system to perform the method of Claim 4 and is thereby rejected under the same reasoning as Claim 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent by DeTore et al. (Patent No.: 4,975,840), and further in view of the publication by McMillan et al. (Publication No.: US 2004/0039710).

As to Claim 17, *DeTore* teaches a method for using medication and medical condition information in automated insurance underwriting, the method implemented on a tangibly embodied computer readable medium in the form of executable code for causing a processor to use medication and medical condition information in automated insurance underwriting, the method comprising the steps of:

inputting an insurance application that includes medication related information and medical condition related information (see at least Figure 1; Col. 4, lines 21-35; and Col. 6, lines 38-61);

identifying medication information provided by an applicant, including extracting the medication related information from an insurance application (see at least Col. 8, lines 8-39);

identifying medical condition information provided by the applicant, including extracting the medical condition related information from an insurance application (see at least Col. 8, lines 8-39);

assessing a consistency between the medication information and the medical condition information, such assessing including performing a comparison between medication information and the medical condition information (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36);

making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information, the making at least one insurance underwriting decision performed by the processor (see at least Figure 1; Col. 3, line 63 through Col. 6, line 8; Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36);

the assessing a consistency including:

generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

comparing the list of possibly treated conditions with the medical condition information provided by the applicant, the comparing resulting in the consistency being identified between the medication information and the medical condition information (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

the generating a list of possibly treated conditions including querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions, and generating the list of possibly treated conditions is performed based on results from the querying of the medical knowledge database (see at least Col. 5, line 40 through Col. 6, line 21; Col. 10, line 31 through Col. 11, line 36; and Col. 12, lines 1-36).

Although *DeTore* substantially teaches the invention of Claim 17, it does not explicitly teach standardizing medication related information to generate the medication information and standardizing medical condition related information to generate the medical condition information. *McMillan* does teach standardizing medication related information to generate the medication information and standardizing medical condition related information to generate the medical condition information (see at least ¶[0023], and ¶[0026]-¶[0031]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of *McMillan* with those of *DeTore* in order to automate the underwriting process making it possible to perform more complex processes using greater volumes of data is less time.

As to Claim 18, *DeTore* teaches assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information (see at least Abstract; Col. 1, line 59 through Col. 2, line 51; and Col. 8, lines 8-39).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRENE KANG whose telephone number is (571)270-3611. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRENE KANG/
Examiner, Art Unit 3695
4/27/2010

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 3695